

## **REMARKS**

This paper is submitted in response to the Office Action mailed on June 4, 2008.

### **Response to Claim Objections**

Claims 10-14 were objected to because of the following informalities: Claim 10 has no separation between the preamble and the body of the claim, as it appears to be one long paragraph which is not proper construction of method claims. For similar reasons, claims 11-14 are objected to.

In response, applicant has amended claims 10 and 12. Accordingly, applicant requests respectfully that the Examiner reconsider and withdraw the objection regarding the format of the claims.

Claim 13 is objected to because the term ‘(specification)’ is used. In response, applicant has deleted the term “specification” from claim 13. Accordingly, applicant requests respectfully that the Examiner reconsider and withdraw the objection to claim 13.

The Examiner objected to claim 12, stating that the specification fails to provide proper antecedent basis for the claimed subject matter. In response, applicant cites the following exemplary support in the specification, at page 5:

Server 116, representative of one or more servers, includes a processing unit 1161, and a memory 1162. Memory 1161, which can take the form of an electronic, magnetic, or optical computer- (or machine-) readable medium, includes one or more one or more search engines, and other modules and software, such as browser-compatible user-interface elements (UIEs) for receiving and fulfilling queries from clients.

This passage teaches that the medium can take the form of an electronic, magnetic, or optical medium.

Accordingly, applicant requests respectfully that the Examiner reconsider and withdraw the objection of claim 12.

### **Response to §101 Rejection**

Claim 13 were rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter.

In response, applicant submits respectfully that claim 13 is directed to a browser-compatible user interface. The user interface facilitates human interaction with or control of a computing device, and therefore is regarded as an article of manufacture or device. Moreover, applicant is not aware of any case law or administrative rulings that indicate that a user interface constitutes non-statutory subject matter. The Examiner indicates that he construes a browser-compatible user interface as software per se, yet provides no documentation to support this conclusion. Lastly, applicant asks the Examiner to consider not only that there are numerous design patents on user interface features, but also the question of whether the user interface on his own workstation constitutes something that is indeed functional and utilitarian.

Accordingly, applicant request respectfully that the Examiner reconsider and withdraw the §101 rejection.

### **Response to §102 Rejection Based on Rivette**

Claims 1-14 were rejected under 35 U.S.C. §102(b) for anticipation by Rivette (U.S. Publication No. 5,991,751). In response, applicant submits respectfully that one of skill would not regard Rivette as identically teaching each and every requirement of the rejected claims.

For example in claims 1-9 and 14, Rivette fails to teach the requisite relationship between the first and second databases, specifically “the first database being a part of an information-management system for the law firm including briefs, client correspondence, advisory opinions, or legal memoranda of the law firm.” Moreover, within the Action itself (see the 103 rejection based on Rivette and Barney), the Examiner concedes that Rivette lack this feature.

For example in claims 10, 11, and 12, Rivette lacks the requisite interface which provides “search results including both internal law-firm content including briefs, client correspondence, advisory opinions, or legal memoranda and content of the online legal research service.” And in relation to claim 13, Rivette lacks the requisite user interface that enables a user at a law firm workstation within the law firm firewall to access internal law firm work product documents

stored in the law-firm information management system and external case laws documents by initiation or submitted a single query via the interface.”

Regarding claims 10-14 the Examiner points to column 25, lines 39-42 and column 26 lines 60-67 as providing the requisite search capability for internal and external documents. However, close inspection of the cited passage fails to indicate that internal and external documents are searchable via a single query or that search results display results from internal law-firm content along with content of an online legal research service. At best, the cited passages appear to indicate that “a number of search interfaces” are made available to the user. However, one of skill in the art would not equate this with the invention of the claims 10-13.

Accordingly, applicant requests respectfully that the Examiner reconsider and withdraw the §102 rejections based on Rivette.

### **Response to §103 Rejection Based on Rivette**

Claims 1-14 were rejected under 35 U.S.C. §103(a), as obvious over Rivette (U.S. Publication No. 5,991,751).

In response, applicant respectfully submits that the text of this rejection is incomplete. It does not set forth a prima facie case of obviousness of the claimed invention. For example, it does not articulate how Rivette differs from the claimed invention, nor what would move one of skill in the art to modify Rivette to achieve the claimed invention. In fact, beyond the statement of the §103 rejection itself, nothing more is provided.

Accordingly, applicant requests respectfully that the Examiner reconsider and withdraw the §103 rejection based solely on Rivette.

### **Response to §103 Rejection Based on Rivette and Barney**

Claims 1-14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Rivette (U.S. Publication No. 5,991,751) in view of Barney (U.S. Patent No. 6,556,992). In making the rejection, the Examiner concedes that Rivette lacks a teaching of “the first database being a part of an information-management system for the law firm including briefs, client correspondence, advisory opinions, or legal memoranda of the law firm and the second database being external to the information-management system and including case opinions, court documents, law review

articles, statutory materials, or legislative histories.” The Examiner then argues that Barney teaches the requisite first and second database at column 11, lines 1-67. For the first database the Examiner quotes “Such information might include prior art that was not cited in the patent, possible license terms, potential problems with the written description or claims of the patent, information about the inventors, information relating to sales of patented products prior to the filing date, legal opinions, related litigation, and any other information that might be relevant to the patent.” And for the second database the Examiner quotes: “Examples of indirect patent metrics included reported patent litigation results, published case opinions, patent licenses, marking of patented products, and the like.”

In response, applicant submits respectfully that nothing in the specific quotations nor in the entire cited passage nor in the entirety of Barney teaches that such information is provided in first and second separated databases or that even if they were in separate databases that the second database is outside or external to the system including the first database. Plus, applicant found no teaching in Barney to provide the data used as basis for its scoring in direct response to user queries. As such, the proposed combination even if permissible fails to teach the requisite first and second databases.

Accordingly, applicant requests respectfully that the Examiner reconsider and withdraw the §103 rejection of claims 1-9 based on Rivette and Barney.

Regarding claims 10-14, applicant submits respectfully that it is unclear how or what combinations of Rivette and Barney are relied upon. The text of the rejection does not appear to rely on Barney for these claims. Accordingly, applicant requests respectfully that the Examiner reconsider and withdraw the §103 rejection of claims 10-14 based on Rivette and Barney.

### **Reservation of Rights**

In the interest of clarity and brevity, Applicant may not have equally addressed every assertion made in the Office Action, however, this does not constitute any admission or acquiescence. Applicant reserves all rights not exercised in connection with this response, such as the right to challenge or rebut any tacit or explicit characterization of any reference or of any of the present claims, the right to challenge or rebut any asserted factual or legal basis of any of

the rejections, the right to swear behind any cited reference such as provided under 37 C.F.R. § 1.131 or otherwise, or the right to assert co-ownership of any cited reference. Applicant does not admit that any of the cited references or any other references of record are relevant to the present claims, or that they constitute prior art. To the extent that any rejection or assertion is based upon the Examiner's personal knowledge, rather than any objective evidence of record as manifested by a cited prior art reference, Applicant timely objects to such reliance on Official Notice, and reserves all rights to request that the Examiner provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03. Applicant reserves all rights to pursue any cancelled claims in a subsequent patent application claiming the benefit of priority of the present patent application, and to request rejoinder of any withdrawn claim, as required by MPEP § 821.04.

**CONCLUSION**

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's representative at (612) 349-9593 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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By / \_\_\_\_\_ /  
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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on November 4, 2008.

/ Jonathan Ferguson /

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